

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10031155-1

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on _____

Signature _____

Typed or printed name _____

Application Number

10/788,519

Filed

02/27/2004

First Named Inventor

James Daren Bledsoe

Art Unit

2625

Examiner

Nguyen, Allen H

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/P. S. Dara/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

P. S. DARA

Typed or printed name

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26 September 2008

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

James Daren Bledsoe *et al.*

Serial No.: 10/788,519

Filed: 02/27/2004

Confirmation No.: 6922

Group Art Unit: 2625

Examiner: Nguyen, Allen H

Docket No. 10031155-1

For: **PROGRAMMABLE CONTROLLER SYSTEM AND METHOD FOR SUPPORTING
VARIOUS OPERATIONAL MODES IN PERIPHERAL DEVICES**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants courteously request consideration of this Pre-Appeal Brief Request for Review, which is being filed together with a Notice of Appeal, in response to the decision of Examiner Allen H Nguyen in the Advisory Action mailed August 22, 2008 issued subsequent to a final Office Action dated May 28, 2008.

AUTHORIZATION TO DEBIT ACCOUNT

Appellants have paid the necessary fees for processing this Pre-Appeal Brief Request for Review. However, if Appellants have inadvertently overlooked the need for additional fees please charge any such fees required or credit any overpayment to Deposit account no. 50-3718.

STATUS OF CLAIMS

Claims 26-31 and 41-46, which all stand rejected, are pending in the present application. Claims 32-40 have been withdrawn in response to a restriction requirement.

The final Office action rejects claims 26-31 under 35 U.S.C. §102(e) as being anticipated by Parry *et al* (U.S. 7,043,166) and further rejects claims 41-46 under 35 U.S.C. §103(a) as being unpatentable over Parry *et al* (U.S. 7,043,166) in view of Sugita (US 2004/0068548).

ARGUMENTS

Claim 26

Appellants respectfully assert that the rejection of claim 26 under 35 U.S.C. §102 is legally deficient for at least the following reasons:

- 1) the rejection fails to unambiguously identify prior art elements that allegedly anticipate the claim elements of Appellants' claim 26, and
- 2) the rejection uses an obviousness type of conclusion that is inappropriate for a rejection under 35 U.S.C. §102.

To elaborate on item 1) above, Parry discloses two memory elements: a) memory module (110) and b) Printing device memory (132). Both these elements are shown in Parry's Fig. 3.

In page 3, line 3 of the Office action, it is alleged that Appellant's memory device is anticipated by Parry's Memory module 110. Consequently, in carrying out a proper rejection, it would be logical to explain why the Examiner believes that Parry's Memory module 110 has characteristics anticipating those cited in Appellant's memory of claim 26 – more specifically the memory capacity limitations ascribed to Appellants' memory. However, instead of providing such an explanation, Examiner chooses to describe memory limitations associated with a different device – a memory contained in Parry's host printing device, i.e. Printing device memory (132) rather than Memory module 110.

To explain further, attention is drawn to page 3, lines 13-17 of the Office action wherein it is asserted that a portion of Appellants' claim 26 which cites "*wherein the memory capacity is selected to preclude storing the plurality of firmware code segments in their entirety*" is anticipated because Parry's "*firmware interface (104) can be uploaded to the memory of a printing device to allow the printing device to access and execute the firmware code (103) while the firmware code (103) remains stored on the memory module (110) and is not uploaded to the memory of the host printing device; see col. 3, lines 57-62*" (emphasis added). As can be understood from the emphasized portion, the Office action is now insisting that it is the memory contained in the host printing device that has limited memory capacity, (rather than Memory module 110) thereby leading to Appellants' contention that the rejection fails to unambiguously identify anticipatory prior art elements.

Turning now to item 2) listed above, it is unclear if the rejection is depending upon an obviousness conclusion or an inherency argument to assert that the prior art memory (whichever element it may be) anticipates a portion of Appellants' claim 26 that cites: "*wherein the memory*

capacity is selected to preclude storing the plurality of firmware code segments in their entirety."

Clearly, it would be improper to rely on an obviousness conclusion for carrying out a rejection under 35 U.S.C. §102.

Alternatively, let be presumed that the rejection is based on an inherency argument. Such a presumption is bolstered by item 3) on page 2 of the Advisory action wherein it is asserted that *"Inherently, in some instances, the new firmware code (103, fig. 1) may replace or overwrite some or all of the firmware previously store in the printing device memory (132). Therefore, a printing device containing a memory having a limited capacity to overwrite (preclude or keep from happening) storing all of the firmware code segments in their entirety (Col. 5, lines 40-42)"* (emphasis added). Appellants respectfully submit that judging by this logic any replacement or overwriting of code in memory would suggest limitations in memory capacity. If this were indeed true, one would have to conclude that any replacement or overwrite operations carried out upon a computer hard drive (C: drive) is done so due to memory limitations in the hard drive. Clearly, this is not the case. In fact, Parry carries out such replacement/overwrite operations for purposes of carrying out firmware upgrades (col. 3, lines 5-11).

Furthermore, to infer that a reference inherently discloses a limitation as claimed, it must be shown that the limitation necessarily flows from the reference. In accordance with MPEP § 2112 Part IV, to meet the burden of establishing the asserted implicit or inherent teachings, the rationale or evidence tending to show inherency must be provided. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference ... The mere fact that a certain thing may result from a given set of circumstances is not sufficient,' ... 'In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.'" ... (Emphasis in original), MPEP § 2112 Part IV. In rejecting Appellant's claim 26, the Examiner has failed to show that Parry's memory device must necessarily have limited memory capacity. To the contrary, Parry in his col. 3, lines 8-11 teaches installing firmware upgrades on a printing device by *"storing firmware components on a memory module attached to a printing device consumable and uploading that firmware to the printing device for storage in the memory of the printing device."* One of ordinary skill in the art would not reasonably interpret this sort of provisioning (providing capacity in a memory of the printing device) as an attempt to limit memory capacity inside the printing device.

In light of the remarks above, Appellants respectfully submit that the rejection of claim 26 is legally deficient and request that the rejection be overruled and overturned.

Claims 27-31

Appellants draw attention to arguments presented on pages 9-10 of Appellants' response dated 25 July 2008 and request that the rejection of these claims be overturned. Furthermore, in response to page 2, item 3) of the Advisory action, Appellants respectfully submit that the statement "A flag may include determining whether the firmware already present in the printing device memory is an older version..." does not constitute a logical basis for rejecting Appellants' claims 29 and 30, more so when claim 30 recites a "flag which when reset is indicative of an absence of the selected firmware code segment..." Clearly, in the prior art, a version number cannot be sought for firmware code that is not present in the memory (i.e. a "flag" does not exist).

Claim 41

Appellants respectfully assert that the rejection of claim 41 under 35 U.S.C. §103 is legally deficient for at least the following reasons:

- 1) the rejection fails to provide a logical reason for modifying Parry in light of Sugita.
- 2) the rejection fails to explain how this modification would be carried out

To elaborate on item 1) above, Parry's invention is directed at installing firmware upgrades (or new functionalities) on a printing device via a printing device consumable (e.g. a disposable toner cartridge). The Office action fails to provide a valid reason as to why one would desire to replace Parry's printing device consumable with a host processor (such as Sugita's), more so one having a memory containing an entire set of firmware code segments.

It may also be pertinent to point out that any rationale provided for enhancing the memory capacity (storing entire set of FW code segments) in either Parry's Memory device 110 or his Printing device memory 132 directly contradicts any assertion made relating to "limited memory capacity" in these devices for carrying out the rejection of claim 26 under 35 U.S.C. §102.

To elaborate on item 2) above, in rejecting a claim under 35 U.S.C. §103, per MPEP 706.02(j), *the Examiner should set forth in the Office action: ... (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter.* However, in the present instance, the Office action fails to disclose how Parry may be modified in light of Sugita, thereby leading to ambiguities such as: a) is the examiner proposing that Parry's Printing device consumable (120) be modified so as to include a processor and a larger memory such that Printing device

consumable (120) can be transformed to arrive at Appellants' "host processor" of claim 41, or b) is the examiner proposing a host processor that is independent of Parry's Printing device consumable (120), wherein this independent host processor is coupled to Parry's Printing device (130) in addition to, or in lieu of, Parry's Printing device consumable (120).

If proposal a) is applicable, it can be appreciated that Parry's Printing device consumable (120) would become more complex/expensive and one of ordinary skill in the art may deem it to be an undesirable modification given the teachings of Parry (vis-à-vis disposable toner cartridge). The Office action does not disclose a reason that would justify the greater complexity/cost.

If proposal b) is applicable, the Office action fails to disclose a reason why one of ordinary skill in the art would be motivated to modify Parry's Printing device (130) (for enabling it to be coupled to a host processor for purposes of downloading firmware code segments) when Parry explicitly teaches away from this "*complicated*" approach in his col. 2, lines 22-34.

In light of the remarks above, Appellants respectfully submit that the rejection of claim 41 is legally deficient and request that the rejection be overturned.

Claims 42-46

Appellants draw attention to arguments presented on pages 13-14 of Appellants' response dated 25 July 2008 and request that the rejection of these claims be overturned.

Furthermore, it may be pertinent to draw attention to page 8 of the Office action wherein Appellant's claim 43 has been rejected as follows: "*Regarding claim 43, Parry '166 discloses the computer network (Network 621, fig. 6), wherein the subset consists of a single firmware code segment (i.e., the printing device can upload the firmware components (102), including, firmware code (103), firmware interface (104), and other data items on the memory module (110); col. 3, lines 29-31, fig. 1).*" Clearly, the rejection has overlooked the fact that the claim cites "*subset consists of a single firmware code segment*" and not "*comprises*."

CONCLUSION

Appellant respectfully requests that the rejection of claims 26-31 and 41-46 be overruled and overturned and the application be allowed to issue as a patent with all pending claims.

I hereby certify that this paper is being electronically transmitted to the Commissioner for Patents on the date shown below:

Date of transmission: 26 September 2008

Signature: /P. S. Dara/

Respectfully submitted,
/P. S. Dara /
Reg. Number 52,793